

Attorney Docket No. P11119

REMARKS/ARGUMENTS**1.) Claim Amendments**

The Applicant has amended claims 1, 2, 37, and 44. Accordingly, claims 1, 2, 7-9, 11-12, 37-50 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected claims 1, 7, 10-12, 37-40, 42, 44-47 and 49 under 35 U.S.C. § 102(e) as being anticipated by Sawyer (US 6,134,438). The Applicants have amended the claims to better define the intended scope of the claimed invention. To the extent that this rejection still applies to the amended claims, the Applicant respectfully traverses this rejection.

The Applicants have amended claims 1, 37, and 44 to clearly delineate that the claims relate to a system and method adapted so that negotiation of operating capabilities take place between the first node and the second node and not between the mobile units. For instance, claim 1 states:

1. A method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising:

receiving a first list of operating capabilities for a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station,
storing the operating capabilities for the first mobile station at the first node,

receiving a second list of operating capabilities for a second mobile station at a second node upstream of and associated with the second mobile station wherein the list is received prior to setting up the call with the second mobile station,

storing the operating capabilities for the second mobile station at the second node,

comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node.

Attorney Docket No. P11119

In contrast, Sawyer appears to relate to the compatibility between a user terminal and the system serving the terminal. There is no question that Sawyer clearly does not teach the underlined claim elements. Thus, a §102 rejection is not proper.

Claims 7, 10-12, 38-40, 42, 45-47 and 49 depend from the amended independent claims and recite further limitations in combination with the novel elements of the independent claims. Therefore, the allowance of the dependent claims is also respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103 (a)

The Examiner rejected claims 2, 8-9, 41, 43, 48, and 50 under 35 U.S.C. § 103(a) as being unpatentable over Sawyer. As noted above, the base claims for claims 2, 8-9, 41, 43, 48, and 50 contain elements which are not found in Sawyer. Furthermore, the references cited by the Examiner do not provide the missing elements. Thus, a §103 claim is not proper. The Examiner's consideration of the amended claims is respectfully requested.

Regarding claims 2, 41, and 48, as the Examiner is aware, the Applicant must object to the use of official notice or waive its right to do so in the future. Thus, to the extent that official notice is still applicable, the Applicant objects to the use of official notice.

As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness." Yet, the Examiner admits that Sawyer does not contain all of the claim elements.

If the Examiner is asserting that the missing limitations of Sawyer are obvious in light of what is "well known in the art" then, as permitted under MPEP § 2144.03, the Applicant requests that the Examiner cite a reference in support of his position for each rejected claim.

Alternatively, if the Examiner is relying on his personal knowledge as the basis for these assertions, the Applicant respectfully objects to the Examiner's use of official

Amendment - PAGE 7 of 8
EUS/J/P/04-8613

Attorney Docket No. P11119

notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. See also 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain the reference.


In either case, the Applicant respectfully requests that the Examiner provide a reference which can be examined and explained by the Applicant. Otherwise, the Applicant respectfully asserts that claim 2, 41 and 48 is in a condition for allowance.

CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-2, 7-9, 11-12 and 37-50.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Amendment - PAGE 8 of 8
EUSI/J/P/04-8613